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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,504	07/29/2002	Peter Brune	RBL0087	9383
7590	12/29/2005		EXAMINER KARMIS, STEFANOS	
Baker & Daniels Suite 800 111 East Waney Street Fort Wayne, IN 46802			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/089,504	Applicant(s) BRUNE ET AL.	
	Examiner Stefano Karmis	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-13 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-13 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed on 06 October 2005.

Status of Claims

2. Claims 1 and 19 are currently amended. Claims 2-5 and 8-13, 20 and 21 are previously presented. Claims 6, 7 and 14-18 are cancelled. Therefore claims 1-5 and 8-13 and 19-21 are under prosecution in this application.

Response to Arguments

3. Applicant's arguments filed 06 October 2005 have been fully considered but they moot in view of the new grounds of rejection set forth below. Therefore claims 1-5 and 8-13 and 19-21 are rejected and Applicant's request for allowance is respectfully declined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent

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in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

5. Claims 1-21 are rejected under 35 U.S.C. 102(d) as being barred by applicant's foreign application 199 46 537.1, filed 28 September 1999.

35 U.S.C. 102(d) establishes four conditions which, if all are present, establish a bar against the granting of a patent in this country: (A) The foreign application must be filed more than 12 months before the effective U.S. filing date (See MPEP § 706.02 regarding effective U.S. filing date of an application); (B) The foreign application must have been filed by the same applicant as in the United States or by his or her legal representatives or assigns. (C) The foreign patent or inventor's certificate must be actually granted (e.g., by sealing of the papers in Great Britain) before the U.S. filing date. It need not be published. (D) The same invention must be involved. If such a foreign patent or inventor's certificate is discovered by the examiner, the rejection is made under 35 U.S.C. 102(d) on the ground of statutory bar. See MPEP § 2135.01 for further clarification of each of the four requirements of 35 U.S.C. 102(d).

The first step requires that the application must be filed more than 12 months before the effective U.S. filing date. In the present situation, the instant application has a filing date of 29 July 2002. The present application claims priority from PCT/DE00/03421 filed on 28 September 2000 and issued on 05 April 2001. Further, the PCT claims priority from 199 46 537.1 filed on 28 September 1999. A certified translation of every foreign benefit application or Patent Cooperation Treaty (PCT) application not filed in English is required under 35 U.S.C. 119(b)(3) and 372(b)(3) and 37 CFR 1.55(a)(4). If no certified translation is in the official record for the application, the examiner must require the applicant to file a certified translation. The applicant

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should provide the required translation if applicant wants the application to be accorded benefit of the non-English language application. Any showing of priority that relies on a non-English language application is prima facie insufficient if no certified translation of the application is on file under 37 CFR 41.154(b) and 41.202(e). In the present situation the application claims priority to PCT/DE00/03421, and therefore it is insufficient since it is not in English and there is no certified translation of the application is on file. Therefore Applicant does not receive the benefit by the non-English application. For at least this reason, the foreign filing date of 199 46 537.1 on 28 September 1999 is more than 12 months before the 29 July 2002 filing date of the instant application. Therefore the limitation set forth in A) above is met.

The remaining three elements are also all met. The applications contain the same inventors, the foreign certificate was actually granted and the applications involve the same invention. Therefore the rejection is made under 35 U.S.C. 102(d) on the ground of statutory bar.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
21 December 2005



HANI M. KAZIMI
PRIMARY EXAMINER